

## REMARKS

Claims 1-11, 30-40, and 59-65 are pending in this application. Applicants' claims have been amended to better clarify Applicants' claimed invention.

Claims 1, 30, and 59, have been amended to recite a method, data storage and retrieval system, and computer program product, respectively, which, *inter alia*, provides or includes a data storage and retrieval system comprising a host computer which includes a plurality of input/output devices. Support can be found in the Specification at Page 9 / Line 12, and in FIG.

1. Claims 1, 30, and 59, have been further amended to recite a data storage and retrieval system which includes a library interconnected to the host computer where that library comprises a plurality of data storage media disposed in a plurality of portable storage cartridges and one or more data storage drives. Support can be found in the Specification at Page 9 / Lines 10 - 12, Page 9 / Lines 20 - 23, Page 10 / Line 3, and in FIG. 1. The Specification defines I/O devices 132 and 134 as data storage drives. *See*, Specification at Page 9 / Line 23.

Claims 1, 30, and 59, have been further amended to a method, data storage and retrieval system, and computer program product, respectively, that maps each of the plurality of input/output devices and the one or more data storage devices." Support can be found in the Specification at Page 15 / Lines 7 - 8.

Claims 3 and 32 have been amended to recite a data storage system which includes a first bus comprising one or a plurality of interconnections. Support can be found in original claims 1, 3, 30, and 32.

Claim 5 has been amended to recite querying each of the plurality of input/output devices and the one or more data storage drives. Support can be found in the Specification at

Page 15 / Lines 9 - 10. Claim 5 has been further amended to recite receiving second information from each of the plurality of input/output devices and the one or more data storage drives. Support can be found in the Specification at Page 15 / Lines 12 - 13.

No new matter has been entered. Reexamination and reconsideration of the application, as amended, is respectfully requested.

Claims 2 and 31 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1, 3, 5, 7, 30, 32, 34, 36, 40, 59, 60, 61, and 65, stand rejected under 35 U.S.C. 102(b) as anticipated by Garner et al. (U.S. Pat. No. 5,014,193).

Claims 2, 4, 8-10, 31, 33, and 62-64 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Garner et al.

The statutory basis and grounds for rejection of claims 6, 11, 35, 37, 38, and 39, are not given in the April 19, 2004 Office Action.

Regarding the rejections of claims 2 and 31 under 35 USC 112, first paragraph, as containing subject matter comprising a "multi-ported device" which was not described in the specification of such a way as to enable one skilled in the art to which it pertains to make and use the invention, [i]t is axiomatic that an "Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage." MPEP 2111.01; *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicants define "multiported devices" as devices "which are capable of interconnecting to a plurality of communication buses." Specification at Page 9 / Lines 16 - 17. Applicants respectfully submit that one of ordinary skill in the art can readily peruse product offerings, i.e. catalogs, to locate

input/output devices which can be connected to more than one communication bus.

Moreover, the Examiner expressly acknowledges that “a routineer in the art would know about SCSI devices having multi-port as SCSI devices are well known in the art.” *See*, April 19, 2004 Office Action at cipher 20. Thus, the Examiner acknowledges that multi-ported devices are well known in the art. Applicants respectfully submit that use of a “multi-ported” device which is, as the Examiner acknowledges, well known in the art, is enabled with respect to one of ordinary skill in that art. This being the case, Applicants’ further respectfully submit that the rejections of claims 2 and 31 under 35 USC 112, first paragraph, have been successfully traversed.

Regarding the rejections of claims as anticipated by Garner et al., it is well-settled that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987); MPEP 2131. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989).

Garner et al. nowhere teaches a method, data storage and retrieval system, or computer program product, which includes or uses a data storage and retrieval system comprising a host computer which includes a plurality of input/output devices, a data storage library interconnected to that host computer, and first information comprising one or more valid system configurations, where that data storage library comprises a plurality of data storage media disposed in a plurality of portable storage cartridges and one or more data storage drives,

as recited by Applicants' claims 1, 30, and 59, respectively, as amended herein.

Moreover, Garner et al. nowhere teaches a method, data storage and retrieval system, or computer program product, which maps each interconnected input/output device, as recited by claims 1, 30, and 59, respectively, as amended herein. Rather, Garner et al. teach a method wherein certain interconnected input/output devices are not mapped. Garner et al. teaches:

The system of the present invention is particularly well suited to interact via bus 36 with a system expansion unit E which would presumably remain at the office or home of the user and house a set of peripheral expansion devices such as a local area network circuit, a second fixed or hard disk drive, additional serial communication ports or additional random access memory circuits.  
**The utilization of such an expansion unit does not form a part of the present invention . . .**

Garner et al. at Col. 2 / Line 60 through Col. 3 / Line 2 (emphasis added).

FIG. 1 of Garner et al. shows expansion unit "E" interconnected with bus 36. Unit "E" includes a "LAN CARD," a "2<sup>ND</sup> HARD DISK," and a "SERIAL CARD." Applicants define input / output devices to include keyboards, pointing devices, scanners, disk drives, CD-ROM drives, printers, display monitors, local area network (LAN) adapters, FAX/modem boards, sound boards, Digital Audio Tape ("DAT") drives, optical storage drives, printers, scanners, photo-composers, and the like. Specification at Page 9 / Lines 12 - 15. Therefore, the devices disposed on the expansion unit "E" of Garner et al. all comprise input/output devices as defined by Applicants.

Garner et al. nowhere teach a method which maps or queries the input/output devices disposed on expansion unit "E". Therefore, Garner et al. fail to teach a method which maps each interconnected input/output device, as recited in Applicants' claims 1, 30, and 59, as amended herein.

Because Garner et al. fails to teach all of the elements of Applicants' claims 1, 30, and 59, as amended herein, Applicants respectfully submit that the rejections of claims 1, 30, and 59, as anticipated by Garner et al. have been successfully traversed.

Claims 3, 5, and 7, depend from claim 1. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore claims 3, 5, and 7, as amended herein, include all the elements of claim 1, as amended herein. Because Garner et al. fails to teach all of the elements of Applicants' claims 3, 5, and 7, as amended herein, Applicants respectfully submit that the rejections of claims 3, 5, and 7, as anticipated by Garner et al. have been successfully traversed.

As noted above, the statutory basis and grounds for the rejections of claims 6 and 11 are not given. Claims 6 and 11, as amended herein, depend from claim 1, as amended herein. Therefore claims 6 and 11, as amended herein, include all the elements of claim 1, as amended herein. Because Garner et al. fails to teach all of the elements of Applicants' claims 6 and 11, as amended herein, Applicants respectfully submit that claims 6 and 11, as amended herein, are novel over the teachings of Garner et al.

Claims 32, 34, 36, and 40, depend from claim 30. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore claims 32, 34, 36, and 40, as amended herein, include all the elements of claim 30, as amended herein. Because Garner et al. fails to teach all of the elements of Applicants' claims 32, 34, 36, and 40, as amended herein, Applicants respectfully submit that the rejections of claims 32, 34, 36, and 40, as anticipated by Garner et al. have been successfully traversed.

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As noted above, the statutory basis and grounds for the rejections of claims 35, 37, 38, and 39, are not given. Claims 35, 37, 38, and 39, as amended herein, depend from claim 30, as amended herein. Therefore claims 35, 37, 38, and 39, as amended herein, include all the elements of claim 30, as amended herein. Because Garner et al. fails to teach all of the elements of Applicants' claims 35, 37, 38, and 39, as amended herein, Applicants respectfully submit that claims 35, 37, 38, and 39, as amended herein, are novel over the teachings of Garner et al.

Claims 60, 61, and 65, depend from claim 59. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore claims 60, 61, and 65, as amended herein, include all the elements of claim 59, as amended herein. Because Garner et al. fails to teach all of the elements of Applicants' claims 60, 61, and 65, as amended herein, Applicants respectfully submit that the rejections of claims 60, 61, and 65, as anticipated by Garner et al. have been successfully traversed.

Regarding the rejections of claims as obvious over Garner et al., it is well-settled that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Garner et al. nowhere teach or suggest a method, or a data storage and retrieval system, or a computer program product, that uses a data storage and retrieval system comprising a host computer which includes a plurality of input/output devices, a data storage library interconnected to said host computer, and first information comprising one or more valid system configurations, where the data storage library comprises a plurality of data storage

media disposed in a plurality of portable storage cartridges and one or more data storage drives, as recited by Applicants' claims 1, 30, and 59, as amended herein.

Moreover, Garner et al. nowhere teach or suggest a method, or a data storage and retrieval system, or a computer program product, which maps each interconnected input/output device, as recited by claims 1, 30, and 59, as amended herein. In fact, Garner et al. teach away from Applicants' claims 1, 30, and 59, as amended herein. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir. 1994).

One of ordinary skill in the art following the teachings of Garner et al. would be motivated to employ a method, or a data storage and retrieval system, or a computer program product, that does not map each interconnected input/output device. In marked contrast, Applicants' claims 1, 30, and 59, as amended herein, recite a method, data storage and retrieval system, and computer program product, respectively, that maps each interconnected input/output device.

This being the case, Applicants respectfully submit that Garner et al. fail to teach or suggest all the elements of Applicants' claims 1, 30, and 59, as amended herein. Claims 2, 4, 8, 9, and 10, depend from claim 1. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Applicants respectfully submit that claims 2, 4, 8, 9, and 10, as amended

herein, are non-obvious over Garner et al.

As noted above, the statutory basis and grounds for the rejections of claims 6 and 11 are not given. Claims 6 and 11, as amended herein, depend from claim 1, as amended herein. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Applicants respectfully submit that claims 6 and 11, as amended herein, are non-obvious over Garner et al.

Claims 31 and 33 depend from claim 30. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Applicants respectfully submit that claims 31 and 33, as amended herein, are non-obvious over Garner et al.

As noted above, the statutory basis and grounds for the rejections of claims 35, 37, 38, and 39, are not given. Claims 35, 37, 38, and 39, as amended herein, depend from claim 30, as amended herein. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Applicants respectfully submit that claims 35, 37, 38, and 39, as amended herein, are non-obvious over Garner et al.

Claims 62, 63, and 64, depend from claim 59. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." "If an independent claim is nonobvious under 35



U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Applicants respectfully submit that claims 62, 63, and 64, as amended herein, are non-obvious over Garner et al.

Having dealt with all of the outstanding objections and/or rejections of the claims, Applicants submit that the application as amended is in condition for allowance, and an allowance at an early date is respectfully solicited. In the event there are any fee deficiencies or additional fees are payable, please charge them, or credit an overpayment, to our Deposit Account No. 502262.

Respectfully submitted,



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